

REMARKS

Reconsideration of the application in view of the present Amendment along and the Request for Continued Examination (RCE) is respectfully requested. A request for a one-month extension of time is enclosed. The Amendment is believed to place the application in condition for allowance.

The Request for Continued Examination and the present Amendment is filed in response to the Advisory Action dated June 18, 2007. In the Advisory Action, the Examiner notes that the proposed amendments to the claims set forth in the Reply filed 31 May 2007 were not entered because they raise new issues that would require further consideration and/or search. In response to the Advisory Action, an RCE is filed herewith to continue examination of the present application. By the present amendment, claims 1 and 6 have been amended, claim 2 has been canceled, and claims 4, 5 and 7-9 continue unamended

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

II. Objections

In the Office Action, claim 1 was objected to for reciting an incorrect reference number for the support regions. In response, the support region has been changed from "support regions (36, 40, 66)" to "support regions (35, 40, 66)." Withdrawal of the objection is respectfully requested.

II. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1, 2 and 4-9 under 35 U.S.C. § 112, second paragraph, as being indefinite, pointing out specific recitations in claim 1 rendering claim 1 and claims 2 and 4-9, dependent thereon, indefinite. Specifically, the Examiner questions how the housing can have the same release direction as the support regions of the adjusting device, as the housing appears to be comprised of multiple parts assembled in multiple directions from multiple locations.

In response, claim 1 has been amended to recite that “all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).”

Generally, the support regions are discussed in the specification (the paragraph, bridging pages 11-12). The release direction (E) is the direction, as pointed in the specification, in which the adjusting device is removed from the housing (4), i.e., all of the support regions face in the same direction.

As such, it is submitted that claim 1, as amended is not indefinite and fully satisfies the requirements under 35 U.S.C. § 112 and is patentable thereunder. Furthermore, claims 2 and 4-9 depend either directly or indirectly from independent claim 1 and recite additional features considered inventive. At least for the same reasons described above, it is submitted that these dependent claims are not indefinite and fully satisfy the requirements under 35 U.S.C. § 112 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

II. Rejection Over the Prior Art

A. Claims 1, 2 and 4-6

The Examiner rejected Claims 1, 2 and 4-6 under 35 U.S.C. §103(a) as being unpatentable over Gerritsen, U.S. Patent No. 5,421,091 (Gerritsen) in view of Morehouse, U.S. Patent No. 1,753,441 (Morehouse) and in further view of U.S. Patent No. 998,318 (Young). Claims 7-8 were rejected respectively under 35 U.S.C. §103(a) as being unpatentable as claims 1-6 above and further in view of Osada, U.S. Patent No. 6,523,267 (Osada) and Smolinski, U.S. Patent No. 5,992,540 (Smolinski). Claim 9 was rejected as claims 1-6 above and further in view of Stowell, U.S. Patent No. RE 37,190 (Stowell). It is respectfully submitted that the pending claims are patentable over the cited references.

A. Claims 1, 2 and 4-6

Independent claim 1 has been amended to further clarify the features considered as being inventive. Specifically, claim 1, as amended, recites:

A motor-driven saber saw (2), comprising a housing (4) having a neck (8) that serves as a handle and has a tool opening (6); guide means (22) for guiding the saber saw (2) on a workpiece and releasably connectable to the housing (4) in a region of the neck (8), the guide means (22) including connection means (21) for connecting the guide means (22) to the housing (4), the neck (8) of said housing (4) having connecting means (16) for guiding the connection means (21); an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing; and a rectilinear spring member (36) for biasing the adjusting device (30) to a locking position thereof and extending substantially parallel to a longitudinal direction of the housing neck (8), said spring member (36) being formed as a springy bar, wherein the neck region (8) of the housing (4) has support regions (35, 40, 66) for the adjusting

device (30) and is formed by a die casting process, said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said locking member (34) releasably engaging said connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4), whereby formation of at least a section of the housing (4), on which the adjusting device (30) is supported, by the die casting process is insured. (Emphasis added).

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 103 for analyzing the features of a claim with respect to the prior art. It is well settled that [t]he test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The combination of the cited patents fails to disclose or suggest that “said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said rib (34) releasably engaging said connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).”

In particular, the three cited patents are completely silent with regard to “a pair of rib guides (35) for receiving a locking member (34) that is retained

therebetween by said spring member (36), said locking member (34) releasably engaging said connection means (16).” Referring to FIG. 1 of the drawings of the present invention, the locking element (34) is inserted between the rib guides (35) and is retained therebetween by an end of the spring member (36). (See specification, page 11, lines 5-16).

Furthermore, even if the Gerritsen, Morehouse and Young patents could somehow be operably combined, nowhere in the combined cited patents is there any disclosure or suggestion regarding “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.” The present invention provides a rectilinear spring member for biasing the locking member to its locking position and which extends substantially in a longitudinal direction of the housing neck. With such a spring member, a very flat mounting space is required for the adjusting device (30) that flatly abuts the housing in the region of the housing neck (8). Advantageously, a slim housing neck can be utilized in the saber saw which permits good handle ergonomics. (see specification, page 4, line 14 to page 5, line 2). By contrast, the cited patents teach away from the present invention, since the plunger 45 of Gerritsen is located at the lower end of the housing of the saber saw, as opposed to the neck/handle of the saber saw.

Accordingly, the present invention provides an adjustment device that is conveniently positioned in the neck of the housing, which serves as a forward handle of the saber saw. Positioning the adjustment device in the neck also facilitates ease of use during operation of the saber saw over the cited prior art, since the user does not have to place his or her hand at the lower end of the saber saw to adjust the guide and risk injury from the blade, especially if the blade is in a

retracted position relative to the saber saw housing. Thus, the present invention reduces the risk of injury to user when adjusting the positioning of the guide.

As such, it is submitted that claim 1, as amended, is not obvious and fully satisfies the requirements under 35 U.S.C. § 103 and is patentable thereunder. Furthermore, claims 2 and 4-6 depend either directly or indirectly from independent claim 1 and recite additional features considered inventive. At least for the same reasons described above, it is submitted that these dependent claims are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

B. Claims 7 and 8

Claims 7 and 8 depend indirectly from independent claim 1 and recite additional features considered inventive. The combination of the cited prior art fails to disclose or suggest that “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing” and “said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said rib (34) releasably engaging said connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).”

As discussed above, the combination of the Gerritsen, Morehouse and Young patents teaches away from the present invention, since these patents are

completely silent with regard to the rib guides (35), the locking member (34) inserted between the rib guides (35) and an adjusting device (30) mountable on the connecting means (16) of said neck (8).

Furthermore, the Osada and Smolinsky patents fail to bridge the substantial gap as between the Gerritsen, Morehouse and Young patents and the present invention. Osada discloses “a front cover, made of an electrically and thermally insulating material, covers an outer surface of the housing. And, a resilient member, which is also electrically and thermally insulating, extends along an outer surface of the front cover partly so as to form a front-end grip to be held by a user.” (See Osada, col. 1, line 38-43 and FIG. 5).

Moreover, Smolinski discloses:

The grip jacket 40 and the housing 11 are arranged so that, in use, the palm of a user's hand rests on the top of the jacket 40, while his fingers wrap beneath the handle portion 42 of the jacket 40 just forwardly of the tab projection 44. ... Preferably, there is also provided a trigger cover 57 formed of a suitable flexible and resilient material, such as a suitable plastic, which covers the trigger pad 56 and has a peripheral lip 58, which engages the inner surface of the jacket handle portion 42 around the periphery of the opening 54, as can best be seen in FIGS. 6 and 8. (See Smolinski, col. 4, lines 23-37).

Even if the five cited patents could operably be combined, nowhere in the combination is there any disclosure or suggestion of “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing” and “said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said rib (34) releasably engaging said

connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).” Therefore, the combination of the cited patents fails to teach or suggest the present invention as a whole.

As such, it is submitted that claims 7 and 8 are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

C. Claim 9

Claim 9 depends indirectly from independent claim 1 and recites additional features considered inventive. The combination of the cited prior art fails to disclose or suggest that “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing” and “said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said rib (34) releasably engaging said connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).”

As discussed above, the combination of the Gerritsen, Morehouse, Young, Osada and Smolinsky patents teaches away from the present invention, since these five cited patents are completely silent with regard to the arrangement between the rib guides (35), the locking member (3) and the spring member (36), as well as the

adjusting device mounted on the connecting means (16) of the neck (8) of the housing (4).

The Stowell patent fails to bridge the substantial gap as between the Gerritsen, Morehouse, Young, Osada and Smolinsky patents and the present invention. The Stowell patent discloses:

Anchored in each concave depression is an array of equi-spaced fins 19. Because the handle is formed of elastomeric material, fins 19 are highly flexible. The array of fins forms a grip site whereby when the fins are pressed in by the forefinger and thumb of a user's hand, this action enhances the user's grip on the handle. (See Stowell, col. 3, line 66 to col. 4, line 4).

Even if the six cited patents could operably be combined, nowhere in the combination is there any disclosure or suggestion of “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing” and “said support regions including a pair of rib guides (35) for receiving a locking member (34) that is retained therebetween by said spring member (36), said rib (34) releasably engaging said connection means (16), and all of the support regions (35, 40, 66) of the adjusting device (30) on the housing (4) are oriented in a direction corresponding to a common release direction (E) of the adjusting device (30) from the housing (4).” Therefore, the combination of the cited patents fails to teach or suggest the present invention as a whole.

As such, it is submitted that claim 9 is not obvious and fully satisfies the requirements under 35 U.S.C. § 103 and is patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

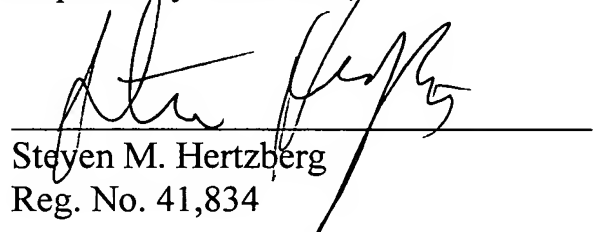
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned at (212) 885-9223.

The Commissioner is hereby authorized to charge any additional fees, or to credit any overpayment, due by reason of this Amendment to Deposit Account No. 01-0035.

Respectfully submitted,



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Dated: July 2, 2007
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